

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed April 12, 2005 (Paper No. 040505). Upon entry of this response, claims 46, 48, and 63 are pending in the application. In this response, claims 46, 48, and 63 have been amended. Applicants respectfully request that the amendments being filed herewith be entered and that there be reconsideration of all pending claims.

1. Allowable Subject Matter

Applicants appreciate the Examiner's indication that claims 48 and 63 would be allowable if rewritten in independent form to include all limitations of the base and intervening claims. Applicant has rewritten claims 48 and 63 in independent form, and therefore respectfully submit that claims 48 and 63 are in condition for allowance.

2. Rejection of Claim 46 under 35 U.S.C. §103

Claim 46 has been rejected under §103(a) as allegedly obvious over *Barron* (U.S. 4,067,844). Applicants respectfully submit that the rejection has been overcome by the claim amendments made herein. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Claim 46

Applicants respectfully submit that claim 46 is allowable for at least the reason that *Barron* does not disclose, teach, or suggest the step of "reacting said product(A) with said

product(B) in such a proportion to produce a urethane resin having no isocyanate group” as recited in amended claim 46.

Claim 1 of *Barron* discloses a “curable organic polymeric material...having at least 2 functional groups per average molecular weight not more than 99% of which are NCO.” Claim 2 of *Barron* discloses “wherein about 75-98% of said functional groups are NCO.”

1) Discussion of the product of claim 46

Since there is no isocyanate group in the product of claim 46, the product does not foam and there are no changes in material viscosity. Accordingly, the product has excellent storage capability and cures quickly when exposed to moisture. Furthermore, a hardened product of claim 46 contains no foam.

Referring to Tables 1-4 on pp. 108-111 of the specification, the products of Examples 1-22 are produced by reacting a prepolymer with a silicon compound in such a proportion to produce a urethane resin having no isocyanate group (NCO content % = 0). Tables 1-4 further show that the changes of viscosity from “after one week” to “after two weeks” are very small, that is, the products have excellent storage stability.

In comparison, Tables 5 and 6 on pp. 112-113 show that the products of Comparative Examples 1-10 have isocyanate (NCO content % > 0). Further, the changes of viscosity from “after one week” to “after two weeks” are relatively large, that is, the products have inferior storage capability. For example, the isocyanate content in Comparative Example 6 is 0.17%, with the viscosity changing from 166,000 to 24,000 mPa·s. As another example, the isocyanate content in Comparative Example 7 is 0.22%, with the viscosity changing from 120,000 to 178,000 mPa·s. As a final example, the isocyanate content in Comparative Example 8 is 0.62%, with the viscosity changing from 8,000 to 16,000 mPa·s.

2) Discussion of the product of *Barron*

Claims 1 and 2 of *Barron* disclose that the final product of *Barron* has two functional groups, one of them is isocyanate, and the preferable range of NCO is 75-98%. Therefore, the isocyanate content of the final product is non-zero. Furthermore, considering the characteristics of *Barron* in comparison to the Comparative Examples of the instant application, the product of *Barron* would not appear to have excellent storage stability, or to cure quickly, or to avoid a bubble in the hardened product.

3) Conclusion

Since *Barron* does not teach at least “to produce a urethane resin having no isocyanate group,” a *prima facie* case establishing an obviousness rejection has not been made. Therefore, claim 46 is not obvious over *Barron*, and the rejection should be withdrawn.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 46, 48, and 63 be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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